

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Mark W. Fagan, et al.) Group: 2853
Serial No.: 10/630,418)
Filed: July 30, 2003)
Title: METHOD OF INFORMING A USER OF AN IMAGING)
APPARATUS OF AN EVENT VIA A PRINT FADE) Examiner: A. Do

LETTER ACCOMPANYING STATEMENT UNDER 37 CFR 3.73(b)

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter accompanies the Statement Under 37 CFR 3.73(b) filed herewith and is supplemental to the Amendment Under 37 C.F.R. 1.116 filed December 29, 2006.

The U.S. Patent and Trademark Office (PTO) renews the objection to the Terminal Disclaimer filed August 22, 2006, indicating that a chain of title demonstrating common ownership between the above-identified patent application (10/630,418) and U.S. Patent Application Serial No. 11/122,399 has not been established. In particular, the PTO asserts that is has not been established that U.S. Patent Application Serial No. 11/122,399 is assigned to Lexmark International, Inc.

Submitted herewith is an Assignment (Exhibit A, two sheets) from Frank Edward Anderson, et al. to Lexmark International, Inc. recorded at reel 013924, frames 0839 – 0841 (re-recorded at reel 016716, frame 0325) which was filed with U.S. Patent Application Serial No. 10/335,221 (Attorney Docket No. 2001-0774.02), now U.S. Patent No. 6,962,399 B2, entitled: Method Of Warning A User Of End Of Life Of A Consumable For An Ink Jet Printer. The assignment of U.S. Patent No. 6,962,399 B2 is also indicated in the face page of the '399 patent.

PATENT
Amendment under 37 CFR 1.116
EXPEDITED PROCEDURE
Group 2853

U.S. Patent Application Serial No. 11/122,399 (Attorney Docket No. 2001-0774.05) entitled "Method Of Informing A User Of End Of Life Of A Consumable For An Ink Jet Printer" is a Continuation Application of prior U.S. Patent Application Serial No. 10/335,221 (the subject of the Assignment of Exhibit A), as evidenced by a copy of the return postcard (Exhibit B, one sheet) and copy of the Continuation Application transmittal papers (Exhibit C, four sheets), which were mailed by Express Mail to the PTO on May 5, 2005.

The scope of the Assignment (Exhibit A) includes "the entire right, title and interest for the United States and its territorial possessions . . . in and to, all Letters Patent to be obtained for said invention by the above application or any **continuation**, division, renewal, or substitute thereof, and as to letters patent any reissue or re-examination thereof." (Emphasis added).

Accordingly, it is respectfully submitted that the chain of title showing that Lexmark International, Inc. is the assignee of the entire right, title and interest in U.S. Patent Application Serial No. 11/122,399 has been established, and in turn, has established that the present application (10/630,418) and 11/122,399 are commonly owned.

Respectfully submitted,

/Ronald K. Aust/

Ronald K. Aust
Registration No. 36,735
Attorney for Applicants

RKA/ts
TAYLOR & AUST, P.C.
12029 E. Washington St.
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0801

Electronically Filed: January 12, 2007

2003-0030.02/LII0587.US

EXHIBIT A

Practitioner's Docket No. 2001-0774.02

ASSIGNMENT OF INVENTION

For good and valuable consideration, the receipt of which is hereby acknowledged

ASSIGNORS:

Frank Edward Anderson
700 Davis-Turkeyfoot Rd.
Sadieville, KY 40370

George Keith Parish
11 Fontaine Blvd.
Winchester, KY 40391
Nationality: US

Tim Strunk
4838 Wyndhurst Rd.
Lexington, KY 40515

John Dennis Zbrozek
902 Granville Court
Lexington, KY 40503

hereby sell, assign and transfer to

ASSIGNEE:

Lexmark International, Inc
740 West New Circle Road
Lexington, KY 40550

and the successors, assigns and legal representatives of the ASSIGNEE the entire right, title and interest for the United States and its territorial possessions in and to any and all improvements which are disclosed in the invention entitled:

Method of warning a user of end of life of a consumable for an ink jet printer

and which is found in (37 C.F.R. Section 3.21) U.S. patent application executed on even date herewith and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, renewal, or substitute thereof, and as to letters patent any reissue or re-examination thereof.

ASSIGNORS hereby covenant that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment.

ASSIGNORS further covenant that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNORS and will testify as to the same in any interference, litigation or proceeding related thereto and will promptly execute and deliver to ASSIGNEE or its legal representatives any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue and enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof.

IN WITNESS WHEREOF, We have hereunto set hand and seal as of the date(s) listed below.

(Assignment of Invention—page 1 of 2)

PATENT
REEL: 013924 FRAME: 0840

IN WITNESS WHEREOF, We have hereunto set hand and seal as of the date(s) listed below.

Frank Edward Anderson
Signature of Frank Edward Anderson

4-1-03
Date

George Keith Parish
Signature of George Keith Parish

7/1/03
Date

Tim Strunk
Signature of Tim Strunk

4/1/03
Date

John Dennis Zbrozek
Signature of John Dennis Zbrozek

April 1, 2003
Date

NOTARIZATION OR LEGALIZATION ACCOMPANYING ASSIGNMENT

Details of Country

United States of America

and place of signing of assignment

Lexington, KY

Before me on the date(s) indicated above, personally appeared the above named individuals, to me known to be the persons who are described in, and who executed the foregoing assignment instrument and acknowledged to me that they executed the same of their own free will for the purpose therein expressed.

Samuel Hays
Notary Public

5/30/04
Commission Expires

(Assignment of Invention--page 2 of 2)

RECORDED: 04/02/2003

PATENT
REEL: 013924 FRAME: 0841

EXHIBIT B

RECEIPT IS ACKNOWLEDGED OF:

TYPE OF PAPER:

U.S. Continuation Patent Application

TITLE: METHOD OF INFORMING A USER OF END OF LIFE OF A
CONSUMABLE FOR AN INK JET PRINTER

APPLICANT: Frank Edward Anderson, et al.

SERIAL NO.: unknown

FILING DATE: Herewith

ENCs.: Transmittal Letter for Continuation Application

Check No. 12747 in the Amount of \$2,400.00

Copy of prior Application S.N. 10/335,221

Copy of Executed Declaration for S.N. 10/335,221

Preliminary Amendment

Information Disclosure Statement

with PTO 1449

DATE MAILED: May 5, 2005

Express Mail No. EV 253887486 US

OUR REF.: 2001-0774.05/LI10489.CON

RKA/ts

113009 U.S. PTO
11/122399
050505

Date: May 5, 2005

EXHIBIT C

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Application for United States Letters Patent

APPLICANT: Frank Edward Anderson, et al.

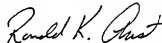
TITLE OF INVENTION: METHOD OF INFORMING A USER OF END OF
LIFE OF A CONSUMABLE FOR AN INK JET PRINTER

Sir:

Forwarded herewith is the above-identified application, consisting of the following:

Transmittal Letter for Continuation Application
Check No. 12747 in the Amount of \$2,400.00
Copy of prior Application S.N. 10/335,221
Copy of Executed Declaration for S.N. 10/335,221
Preliminary Amendment
Information Disclosure Statement
with PTO 1449

Respectfully submitted,



Ronald K. Aust
Registration No. 36,735
Attorney for Applicant

RKA/ts

TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
FAX: 317-894-0803

"EXPRESS MAIL" Mailing Number EV 253887486 US

Date of Deposit May 5, 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Ronald K. Aust, Reg. No. 36,735

(Typed Name of Person Mailing Paper or Fee)



(Signature of Person Mailing Paper or Fee)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 2001-0774.05

Prior Application : 10/335,221

Prior Examiner : L. Nguyen

PriorArt Unit : 2853

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for filing a [X] continuation [] divisional application under 37 C.F.R. 1.53(b) of:

Prior Application Serial No: 10/335,221 filed: December 30, 2002

of: Frank Edward Anderson, et al.

(Inventor(s) currently of record in prior application)

entitled: METHOD OF INFORMING A USER OF END OF LIFE OF A
CONSUMABLE FOR AN INK JET PRINTER

(Title of Invention)

1. [X] Enclosed is a copy of the prior application, including the oath or declaration as originally filed.

2. The filing fee is calculated as follows:

CLAIMS AS FILED IN THE PRIOR APPLICATION, LESS ANY CLAIMS
CANCELED BY AMENDMENT BELOW

				CHECK IF LARGE ENTITY				
ITEM	NUMBER FILED		EXTRA	SMALL ENTITY		LARGE ENTITY		TOTAL FEES
				RATE	FEE	RATE	FEE	
Basic Filing Fee				\$150.00	\$0.00	\$300.00	\$300.00	\$300.00
Patent Search Fee				\$250.00	\$0.00	\$500.00	\$500.00	\$500.00
Patent Examination Fee				\$100.00	\$0.00	\$200.00	\$200.00	\$200.00
Total Claims	32	- 20	12	\$25.00	\$0.00	\$50.00	\$600.00	\$600.00
Independent Claims	7	- 3	4	\$100.00	\$0.00	\$200.00	\$800.00	\$800.00
Multiple Dependent Claims	0	- 0	0	+\$180.00	\$0.00	+\$360.00	\$0.00	\$0.00
Assignment Recordation Fee				\$40.00		\$40.00		\$0.00
Total Filing Fee:								\$2,400.00

A check in the amount of \$2,400.00 is enclosed. (Check No. 12747)

4. ☒ Please amend the specification by inserting before the first line the sentence:
--This is a continuation of application Serial No. 10/335,221 filed December 30, 2002.--
5. ☐ New informal drawings are enclosed.
6. ☒ The prior application is assigned of record to Lexmark International, Inc.
7. ☐ A new combined declaration and power of attorney is enclosed.
8. ☒ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)
9. ☒ I have reviewed the attached specification and drawings and have determined that no new matter is present therein over prior application Serial No. 10/335,221, filed on December 30, 2002.

10. ☒ Incorporation by Reference: The entire disclosure of the parent application listed herein, from which a copy of the oath or declaration is supplied, is considered to be part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

11. ☒ The Director of the United States Patent and Trademark Office is hereby authorized to charge payment of the following fees or credit any overpayment associated with this communication or during the pendency of this application to Deposit Account No. 20-0095, TAYLOR & AUST, P.C. A duplicate copy of this letter is enclosed.

☒ Any additional filing fees required under 37 CFR 1.16.

☒ Any patent application processing fees under 37 CFR 1.17.

☒ Any fees under 37 CFR 1.16 for presentation of extra claims.

12. ☐ Applicant(s) hereby request(s) that the above-captioned application NOT BE PUBLISHED under 35 U.S.C. § 122(b) and 37 C.F.R. § 1.211. The undersigned hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

13. Please address all future communications to :

Customer Number 000041891

Ronald K. Aust
TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
FAX: 317-894-0803

May 5, 2005

Date

Address of signatory:
Taylor & Aust, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
FAX: 317-894-0803



Ronald K. Aust
Registration No. 36,735
Attorney for Applicant

Enc.:

Postcard

Check: 12747